

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIS J. MULLET

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Appeal No. 2001-2126  
Application 09/141,069

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ON BRIEF

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Before MCCANDLISH, Senior Administrative Patent Judge, COHEN,  
and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Willis J. Mullet originally took this appeal from the final rejection of claims 1 through 6, 8, 10, 11 and 14 through 22.<sup>1</sup> Upon reconsideration, the examiner has since withdrawn the rejection of claim 10 which now stands objected to as depending from a rejected base claim. Thus, the appeal as to claim 10 is hereby dismissed, leaving for review the

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<sup>1</sup> Claims 1, 2 and 10 have been amended subsequent to final rejection.

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standing rejection of claims 1 through 6, 8, 11 and 14 through 22. Claims 7, 9, 12, 13 and 23, the only other claims pending in the application, stand allowed.

#### THE INVENTION

The invention relates to "a combination stop and seal member that operates to position and provide a weather seal for a garage door or the like" (specification, page 1).

Representative claim 1 reads as follows:

1. A combination stop and seal member for a door operatively movable between an open position and a closed position in relation to a door frame comprising, a base for attaching the member to the door frame, a rigid projecting arm extending from said base in an angular relation thereto, a stop block at a distal end of said projecting arm adapted to engage the door when the door is in the closed position, and a flexible member extending from said projecting arm at a location adjacent to said stop block and adapted to sealingly engage the door when the door is in the closed position.

#### THE REJECTION

Claims 1 through 6, 8, 11 and 14 through 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,472,469 to Thies.

Attention is directed to the appellant's brief (Paper No. 15) and to the examiner's answer (Paper No. 16) for the

respective positions of the appellant and the examiner with regard to the merits of this rejection.<sup>2</sup>

#### DISCUSSION

Thies discloses a sealing strip adapted to be attached to a vehicle bodywork flange. As described by Thies, the Figure 1 embodiment relied on by the examiner

is composed of a holding part 1, and of [a] sealing part, the latter being designed as a lip 2. The holding part 1 is composed of two limbs, 3 and 4, which are interconnected by a web 5. On the inner surfaces, the limbs 3,4 possess holding ribs 6, 7, these ribs serving to improve the grip on a vehicle bodywork flange, onto which the holding part 1 is to be pushed. The holding part is endowed with the necessary gripping strength by means of a metallic reinforcing insert 8 which is composed, for example, of a steel wire, bent into a zigzag shape, and which passes through the two limbs 3, 4, and through the web 5 . . . . The insert is encased, with the profile section indicated in the drawing, by a thermoplastic material, such as, for example, polyvinyl chloride, the hardness of which is adjusted to the level customary for profile sections used of protecting edges on motor vehicles.

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<sup>2</sup> In the final rejection (Paper No. 6), claims 1 and 2 also stood rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. As the examiner has not restated this rejection in the answer, we assume it has been withdrawn (see Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957)) in light of the amendments made subsequent to final rejection (see n.1, supra).

The sealing lip 2 departs from the holding part 1 in the region of the transition-between the limb 4 and the web 5. It is composed of essentially the same material, but its hardness is adjusted to a somewhat lower value. . . . The thermoplastic material forming the holding part 1 and the sealing lip 2 is co-extruded, by a known technique, the two grades of material being securely welded to one another in the transition region.

The sealing lip 2 contains a reinforcing insert 10, composed of spring steel wire, bent into a zigzag shape, this wire being thinner than that of the reinforcing insert 8. The strength of the reinforcing

insert 10 and the thickness of thermoplastic material surrounding it are chosen, by design, such that the desired sealing force and compliance results when the sealing lip is deformed by the expected amount [column 4, lines 21 through 59].

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

The examiner's determination that Thies discloses each and every element of the invention set forth in the appealed claims rests on the analysis that

Thies (See appendix B)<sup>[3]</sup> shows a base (3) having a rigid projecting arm (5) extending from said base, an anvil-shaped stop block (13) at a distal end of said projecting arm, a flexible member (2) overlaps and [is] fused to the a portion of distal end of said projecting arm at a location adjacent to said stop block, said base and said projecting arm being constructed of a resin, said flexible member being constructed of a flexible resin attached to said projecting arm, said projecting [arm] being angularly offset from said base at an acute angle, said base being substantially rectangular with the projecting arm attached to said base proximate a corner thereof.

Thies's structure is inherently capable of being adapted to be used in conjunction with the door and its usage conditions [answer, page 4].

The examiner's determination that Thies' limb 4 (the numeral 13 referred to by the examiner denotes the thermoplastic material of limb 4) constitutes a stop block (or means) as recited in the claims on appeal is not well taken. As indicated above, independent claim 1 requires the stop block to be "adapted to engage the door when the door is in the closed position." In a similar vein, independent claim 14 recites a stop block "for positioning the door when the door is in the closed position," independent claim 18 calls for

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<sup>3</sup> Appendix B, which is attached to the answer, consists of a copy of Thies' drawings with Figure 1 color coded and labeled in accordance with the examiner's analysis.

stop means "for engaging the door when the door is in the closed position," and independent claim 21 sets forth a stop block and flexible seal "adapted to simultaneously engage the door." These limitations employ functional language to define the stop block by what it does rather than by what it is.<sup>4</sup> Thies neither expressly teaches that limb 4 performs the foregoing functions nor provides the factual basis necessary to find that the structure embodied by limb 4 is inherently capable of so functioning. Thus, the examiner's apparent position that limb 4 meets the stop block (or means) limitations in claims 1, 14, 18 and 21 under principles of inherency is completely conjectural and without merit. Hence, Thies cannot be said to disclose, either expressly or under principles of inherency, each and every element of the subject matter recited in claims 1, 14, 18 and 21.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claims 1, 14, 18 and 21,

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<sup>4</sup> There is nothing intrinsically wrong with this claim drafting technique. See In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971).

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and dependent claims 2 through 6, 8, 11, 15 through 17, 19, 20  
and 22, as being anticipated by Thies.

SUMMARY

The decision of the examiner to reject claims 1 through  
6, 8, 11 and 14 through 22 is reversed.

REVERSED

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Senior Administrative Patent Judge	)	
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	)	APPEALS AND
IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	INTERFERENCES
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